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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,821	09/20/2000	Kenneth J. Kirchhoff	55824USA3A.002	8078
32692	7590	11/03/2005	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			BAXTER, GWENDOLYN WRENN	
			ART UNIT	PAPER NUMBER
			3632	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/665,821

Applicant(s)

KIRCHHOFF, KENNETH J.

Examiner

Gwendolyn Baxter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-10,12-17 and 19-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-10,12-17 and 19-29 is/are allowed.
- 6) ☒ Claim(s) 30-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/22/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

This is the eighth office action for serial number 09/665,821, Adjustable Keyboard Tray, filed on September 20, 2000. Applicant has filed a requested for continued examination filed March 22, 2004.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 30-32 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "the top and bottom plates including a plurality of inner walls along their opposed facing surfaces", does not reasonably provide enablement for the ultrasonically welding together of the plurality of inner walls of the bottom and top plates as provided in the claim. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The specification clearly teaches and provides enablement for the top and bottom plates having inner walls or ribs. See pages 12, lines 23-25; page 17, lines 25-27; page 18, lines 19-27; page 19, lines 30 through page 20, line 1 and page 21, lines 5-7. However there is no support for ultrasonically welding the walls of the top plate together with the wall of the bottom plate as recited in claim 30. The specification clearly teaches "ultrasonically welding along *either* the inner wall 55, the ribs or other inner surface rather than the outer edges...." See page 19 of the specification, lines 20-24. Consequently, the specification does not

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enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,616,798 to Smeenge in view of U.S. Patent No. 5,655,743 to Martin. Smeenge discloses an adjustable keyboard tray comprising a tray (11) having a molded top and bottom plates (not numbered) and a mounting plate (50). The top and bottom plates are made of a polymeric material (col. 5, lines 34+). The mounting plate is secured to the adjustable keyboard tray to the bracketing mechanism (12). The top and bottom plates form a cavity (45) and are made of plastic or synthetic resin. The top surface of the mounting plate is in direct alignment with the top surface of the bottom plate. The bottom plate of the tray is moldedly secured together. However, Smeenge fails to teach the top and bottom plates including a plurality of inner walls along their opposed facing surfaces that are ultrasonically welded together, wherein the inner walls form pockets for receiving a mouse bracket which supports a mouse platform.

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Martin teaches a keyboard tray comprising a top plate (21) and medial plate (22) forming a cavity there between. For purpose of this Office action, the medial plate (22), as referred to in the Martin reference will be referred to as the bottom plate (22) of the keyboard tray. Beneath the bottom plate of the tray is a resilient foam material to rest upon the user's lap. The top and bottom plates are formed of a polymeric material (col. 4, line 4+). The top and bottom plates are secured together, but this reference is silent as to how this bonding is done. A pocket is created along a side of the keyboard tray that is aligned with an opening (33) through the side of the tray to receive and secure a mouse bracket (39), which supports a mouse platform. The mouse bracket is releasably secured in the pocket by a tab (53) and is received in a slot (52) on the mouse bracket. Figure 3 shows the top and bottom plates having a plurality of inner walls, respectively.

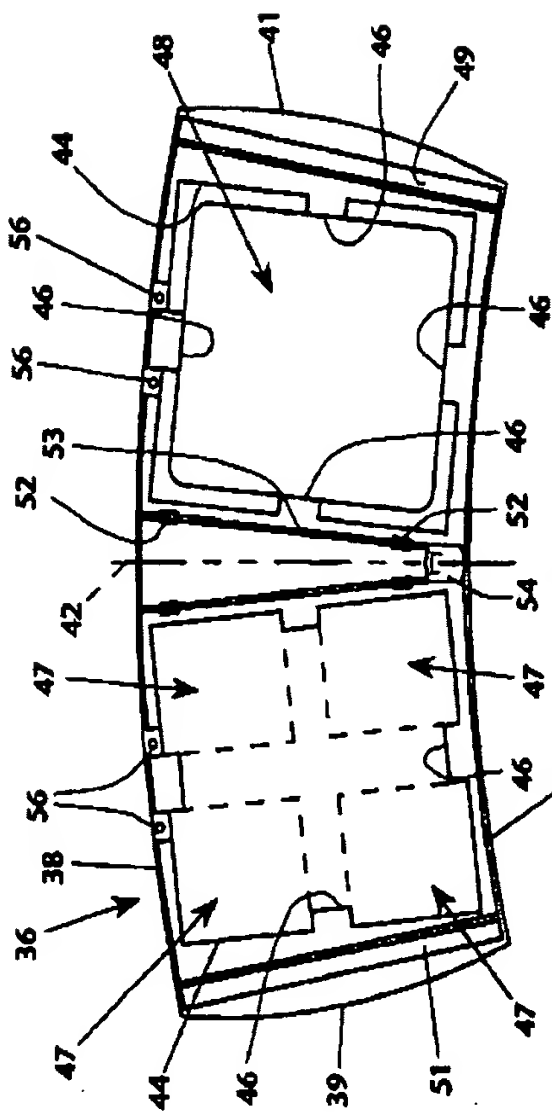


FIG. 5

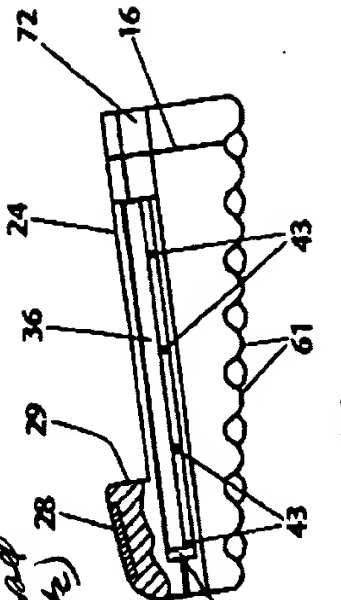


FIG. 4

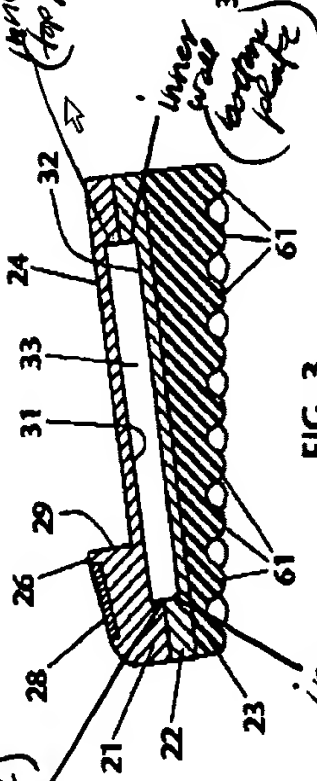


FIG. 3

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the molded integral tray as taught by Smeenge to have incorporated the stackable keyboard tray having molded top and bottom plates as taught by Martin for the purpose supporting a keyboard thereupon as merely functional equivalent parts while simultaneously supporting a mouse thereupon in conjunction with the keyboard.

Regarding claim 30, Martin is silent as to the methodology employed for securing the top and bottom plates. Nonetheless, the combination of Smeenge in view of Martin reads on the present invention. The limitation "opposed facing surfaces that are ultrasonically welded together" has not been given patentability weight, since this limitation is a product by process limitation, and since the process is not critical to the outcome of the product being formed. The patentability of a claim to a product does not depend on merely a difference in its method of production, but on whether the product itself is new and unobvious.

### ***Allowable Subject Matter***

Claims 2-10, 12-17, and 19-29 are allowed

### ***Response to Arguments***

Applicant states the modification to ultrasonically weld the ribs of the top and bottom plates is not taught by Smeenge or Martin. As stated previously this limitation is a product by process limitation and has not been given patentability weight. The

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patentability of a claim to a product does not depend on merely a difference in its method of production, but on whether the product itself is new and unobvious. In this case, the product itself is not a new and unobvious product. Additionally applicant has not provided adequate support in the specification for this limitation in the claims.

Next applicant sets forth the condition for establishing an obviousness rejection.

Applicant states the following:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. M.P.E.P.

2143.01. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P. 2143.01, citing *In re Gordon*. U.S.P.Q. (BNA) 1125 (Fed. Cir. 1984). Furthermore, if the proposed modification or combination of the prior art would change the principle of operation of the prior art



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invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. M.P.E.P. 2143.01, citing In re Ratti, 123 U.S.P.Q. (BNA) 349 (C.C.P.A. 1959).

Then, Applicant proceeds to state "the proposed modification of Martin...." Martin is not the primary reference. Smeenge is the primary reference or the modifying reference in this case. The suggested modification to Smeenge would in no way change the principle of operation or functionality of this prior art reference.

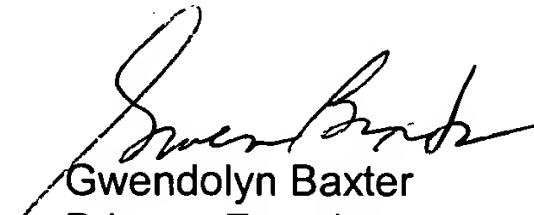
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gwendolyn Baxter whose telephone number is 571-272-6814. The examiner can normally be reached on Monday-Wednesday, 8:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gwendolyn Baxter  
Primary Examiner  
Art Unit 3632

October 29, 2005